

67,010-089; H2751-ED

REMARKS

Applicant wishes to thank the Examiner for the detailed remarks. Claims 1, 4, and 6 have been amended, claims 5, 12, and 19 have been cancelled, and new claims 24-30 have been added. Accordingly, claims 1, 4-6, and 10, 11, 13-18, and 20-30 are pending in the application.

The Examiner rejected claims 15, 17, 19, and 23 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner argues that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Respectfully, the burden is on the Examiner to provide reasons why one would not have recognized that the inventor was in possession of the invention as claimed. General allegations are not enough to support the rejection. See MPEP §2163.04. Since the Examiner has failed to give any reasons why the specification would not reasonably convey that the inventors had possession of the claimed invention, Applicant requests that the rejection be withdrawn.

The Examiner rejected claims 1, 4-6, 13-14, and 20-22 under 35 U.S.C. §102(b) as being anticipated by *Arutunoff*. The Examiner argues that *Arutunoff* discloses all the features of Applicant's claim 1. Amended claim 1 recites a thermally conductive dielectric fluid. *Arutunoff* refers throughout to an internal liquid or oil, but does not disclose the use of dielectric fluid. Indeed, *Arutunoff* does not even mention the word "dielectric." Applicant's claim recites something more than just oil or internal liquid. The oil or internal liquid must have the particular ~~feature of being a dielectric fluid.~~ As an example of the dielectric fluid, Applicant's paragraph 17 discloses synthetic gas turbine engine oils. *Arutunoff* fails to disclose a synthetic gas turbine engine oil and fails to disclose the use of any dielectric fluid or benefit therefrom. *Arutunoff* does not disclose the claimed feature of a dielectric fluid and therefore cannot anticipate claim 1. Accordingly, claim 1 and its dependents are properly allowable.

The Examiner rejected claims 10-12, and 16 under 35 U.S.C. §103(a) as being unpatentable over *Arutunoff* in view of *McCabria*. The Examiner argues that *Arutunoff* discloses all the features of the claims except for a housing having a fluid inlet and a fluid outlet, a fluid pump that circulates a dielectric fluid through the fluid inlet into the cavity and out of the fluid

67,010-089; H2751-ED

outlet, and a fluid reservoir that houses excess dielectric fluid. The Examiner contends that *McCabria* discloses a housing having a fluid inlet and a fluid outlet, a fluid pump, and a fluid reservoir, and that it would have been obvious to modify the housing configuration of *Arutunoff* to accommodate the combination structure as taught by *McCabria* in order to improve the cooling system. Applicant respectfully disagrees.

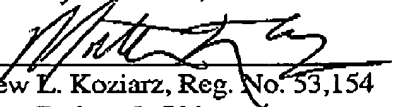
There is no motivation to make the proposed combination. In *Arutunoff*, the oil circulates only within the machine housing. This provides complete temperature equalization within the machine and eliminates deleterious heating of the machine parts. See page 2, lines 102-105. In *McCabria*, the heat exchanger (86) cools the lubricating oil before the oil enters the generator (10) through the inlet ports (C and D). Thus, the oil entering the generator is cooler than the oil exiting the generator and there is no temperature equalization. Therefore, the proposed combination would ruin the intended operation of *Arutunoff* to provide temperature equalization by allowing some parts near the inlets to be cooler than parts near the outlets. Therefore, one would not be motivated to make the proposed combination. Accordingly, claims 10-12 and 16 are properly allowable.

New claims 24-30 have been added and further describe aspects that are not disclosed or suggested by the cited references. No new matter has been added.

Applicant respectfully submits that this case is in condition for allowance. If the Examiner believes that a teleconference will facilitate moving the case forward to being issued, applicant's representative can be contacted at the number indicated below.

Fees in the amount of \$100.00 for 2 additional claims over 20 may be charged to Deposit Account No. 08-0385 in the name of Hamilton Sundstrand. Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge the same deposit account for any additional fees or credit the account for any overpayment.

Respectfully submitted,

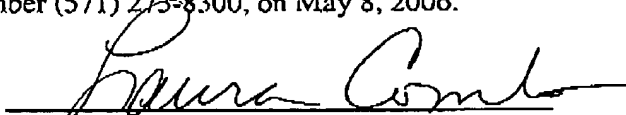
  
Matthew L. Koziarz, Reg. No. 53,154  
Carlson, Gaskey & Olds  
400 W. Maple Road, Ste. 350  
Birmingham, MI 48009  
(248) 988-8360

Dated: May 8, 2006

67,010-089; H2751-ED

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States patent and Trademark Office, fax number (571) 273-8300, on May 8, 2006.

  
Laura Combs